

REMARKS

The Office Action Summary indicates that claims 1 through 24 are pending in the application, that claims 8-10 and 19-23 are withdrawn from consideration, and that claims 1-7, 11-18 and 24 are rejected. However, on page 2 of the Office Action, the Office properly indicates that claims 8-10 and 19-23 have been cancelled, and that claims 1-7, 11-18 and 24 are pending.

Also on page 2 of the Action, the Office indicates that applicant's *amendment* to claims 21-23 are sufficient to overcome the claim objections and rejection under 35 U.S.C. §101. Applicant believes the Office has considered the *cancellation* of these claims as overcoming these objections/rejections.

Rejections under 35 U.S.C. §103

On page 3 of the Office Action, the Office rejected claims 1-5, 11-18, and 24 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0036914 to Fitzpatrick et al. in view of U.S. Patent No. 6,480,831 to Cordery et al. On page 9 of the Office Action, the Office rejected claims 6-7 under 35 U.S.C. §103(a) as being unpatentable over Fitzpatrick in view of Cordery and further in view of U.S. Patent No. 4,390,981 to Wood et al.

In the most recent rejection, the Office newly cites the Cordery patent and asserts that Cordery, with its teaching of transmitting keys from a postage metering device to remote data center, renders the claimed invention obvious under 35 U.S.C. §103(a) when combined with the teachings of Fitzpatrick. Applicant respectfully disagrees with this assertion, since neither

reference provides any reason that would have prompted a person of ordinary skill in the relevant field to reasonably combine the elements in the way the claimed new invention does, and thus the combination does not meet the requirements of *KSR (KSR International Co. v. Teleflex Inc.)*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007). (Applicant characterized the requirements of KSR in its previous response and incorporates them by reference herein). Accordingly, Applicant respectfully requests the Office to reconsider and withdraw the rejection of the claims

The present invention enables the communication of contact information between a device and a further device, and the claims include a hash key to be transmitted to the further device, which causes each of the devices to generate digests of contact entries in their contact stores using the hash key. The digests generated by the further device are transmitted to the (first) device, and the digests are used to compare the contact stores. In the present claimed invention, when the users decide to exchange contacts information, the respective devices each generate digests of the contacts in the respective contacts stores and only the digests are transferred between devices and used to discover common contacts, and this discovery process uses the hash key transmitted from one device to the other device. Therefore, the common contacts can be discovered without the transfer of the potentially sensitive contacts information. This is a particularly beneficial way of discovering common contacts, and is not disclosed or suggested by a combination of Cordery and Fitzpatrick, as is suggested by the Examiner.

As Applicant acknowledged previously, Fitzpatrick does appear to disclose a type of mutual contacts discovery system. In the examples described in Fitzpatrick, common contacts between two devices can be notified using a contact clearing house, as described

with reference to Figures 1 to 4, or directly between devices, as described with reference to Figure 5. However, nothing in Fitzpatrick, discusses, mentions, or indicates any need or desire to generate *digests* of the contacts in the respective contacts stores and to only transfer the *digests* between devices to enable discovery of common contacts. Further, nothing in Fitzpatrick, discusses, mentions, or indicates any need or desire to perform a discovery process using a hash key transmitted from one device to the other device.

The addition of Cordery fails to supply the reasons, required by KSR, for providing such features (features which are claimed in all of the pending claims). First, Cordery has nothing whatsoever to do with identifying common contact information contained on two devices; Codery is concerned with securely transmitting a key from a first device to a second device, i.e., from a postage meter to a remote data center. It does not in any way involve discovery of information on one device by another device using hash keys; Cordery is concerned with preventing the printing of postage by an unauthorized computer due to the use of fraudulent verification information, and thus nothing in Cordery would reasonably suggest generating digests of *contacts* in contacts stores of two devices and to only transfer the *digests* between devices to enable discovery of common contacts. As such, the combination proposed by the Examiner fails to meet the requirements of KSR.

The addition of Wood, like Cordery, also contains no teaching or suggestion of generating digests of *contacts* in contacts stores of two devices and to only transfer the *digests* between devices to enable discovery of common contacts.

In view of the arguments submitted herein, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1-7, 11-18 and 24 under 35 USC §103.

Conclusion

The present invention is not taught or suggested by the prior art. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims. An early Notice of Allowance is earnestly solicited.

The Commissioner is hereby authorized to charge the extension fee, and any additional fees associated with this communication to applicant's Deposit Account No. 50-4364.

Respectfully submitted

January 25, 2010
Date

/Mark D. Simpson/
Mark D. Simpson, Esquire
Registration No. 32,942

SAUL EWING LLP
Centre Square West
1500 Market Street, 38th Floor
Philadelphia, PA 19102-2189
Telephone: 215 972 7880
Facsimile: 215 972 4169
Email: MSimpson@saul.com